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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,536	03/28/2001	Preeti Lal	PF-0610 USN	1220

7590 05/16/2003
Incyte Genomics Inc
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

MERTZ, PREMA MARIA

ART UNIT PAPER NUMBER

1646

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/806,536

Applicant(s)
Lal et al.

Examiner
Prema Mertz

Art Unit
1646



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 9, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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DETAILED ACTION

1. This application is a 371 of PCT/US99/23434. For applications filed under 371, PCT rules for lack of unity apply.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-14. Claims 3-6, 9-14, are drawn to a nucleic acid encoding a protein of amino acid sequence as set forth in SEQ ID NO:1-8, 10-15, a vector, a host cell and a process for producing the receptor polypeptide.

Groups 15-28. Claims 1-2, 15 are drawn to a polypeptide of amino acid sequence as set forth in SEQ ID NO:1-8, 10-15.

Group 29-42. Claim 16 is drawn to an antibody to a polypeptide of amino acid sequence as set forth in SEQ ID NO:1-8, 10-15.

Group 43-56. Claim 19 is drawn to a method of treatment by administering the polypeptide of amino acid sequence as set forth in SEQ ID NO:1-8, 10-15.

Group 57-70. Claims 7-8, are drawn to a method of diagnosing a pathological condition using the nucleic acid encoding the polypeptide of amino acid sequence as set forth in SEQ ID NO:1-8, 10-15.

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Group 71-84.Claim 20, is drawn to a method of treatment by administering an antagonist to the polypeptide of amino acid sequence as set forth in SEQ ID NO:1-8, 10-15.

Group 85-98.Claims 1718 are drawn to an agonist or antagonist to the polypeptide of amino acid sequence as set forth in SEQ ID NO:1-8, 10-15.

Should any one of the Groups from 1-98 be elected, Applicant is required to select one polypeptide (one amino acid sequence) as set forth in SEQ ID NO:1-8, 10-15. Once one polypeptide sequence is selected, all other sequences will be withdrawn from consideration.

The inventions listed as Groups I-98 do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2 they lack the same or corresponding special technical feature for the following reasons:

The first claimed invention fails to recite such a feature, since the nucleic acids of inventions 1-14, 15-42, 85-98, encode isolated proteins which are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The polynucleotides of inventions 1-14 can be used to make hybridization probes or can be used in gene therapy as well as in the production of the specific proteins of interest. The proteins of inventions 15-28 can be used as probes, or used therapeutically or diagnostically, e.g. in screening. The antibodies of inventions 29-42 can be used to obtain the polynucleotides of Groups I-14, and can also be used in diagnostics, e.g. as a probe in immunoassays. Each of the polynucleotides of inventions I-14 can be used to produce the specific polypeptides of Groups 15-

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28, respectively. The polynucleotide of Group I can only be used to produce the protein of Group 15 but not the proteins of Groups 16-28.

Inventions I-14 and 15-28 are related as processes of making and products made. In the instant case each of the proteins can be prepared by materially different processes, such as by chemical synthesis, or obtained from nature using various isolation and purification protocols.

Inventions 15-28 and 43-56 are related as products and processes of use. In the instant case the products of inventions 15-28 can also be used as an antigens in the production of specific antibodies.

Inventions 85-98 and 71-84 are related as products and processes of use. In the instant case the products of inventions 15-28 can also be used as an antigens in the production of specific antibodies.

Inventions I-14 and 57-70 are related as products and processes of use. In the instant case the products of inventions I-14 can also be used in production of the protein of interest.

Inventions 1-14 and 43-56, 71-84 are unrelated. In the instant case the different inventions are not disclosed as capable of use together.

Inventions 15-28 and 57-84 are unrelated. In the instant case the different inventions are not disclosed as capable of use together.

Inventions 29-42 and 43-84 are unrelated. In the instant case the different inventions are not disclosed as capable of use together.

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Inventions 85-98 and 43-70, are unrelated. In the instant case the different inventions are not disclosed as capable of use together.

The methods of Groups 43-84 are patentably distinct because each recites method steps not required by the other, and the search of all the methods in one patent application would result in an undue search burden because the methods are practiced with materially different process steps for materially different purposes and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 305-3014 or (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Prema Mertz
Prema Mertz Ph.D.
Primary Examiner
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May 9, 2003